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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,231	03/28/2001	Michael A. Inchalik	82425RLO	3471

7590 12/20/2004

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EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/819,231	INCHALIK ET AL.	
	Examiner	Art Unit	
	Paul Callahan	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/28/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3-28-2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>00272004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-7 are pending in this application and have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the phrase: "...arranged to be difficult for a pirate to copy..." The meaning of the phrase is unclear as it is a relative term. Claims 2-7 are dependent on claim 1 and are thereby rejected on the same basis as that claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being obvious in view of Hurtado et al., US 6,611,812, and Kajiyama et al. US 6,108,296.

As for claims 1 and 6, Hurtado teaches a credit or debit protected optical disk for use with a CD-ROM drive (fig. 18, item 1802) to provide for payment over a network to a seller of supplies or services (abstract) comprising:

(a) an optical disk including a preformed identification signature that is impressed and arranged to be difficult for a pirate to copy (col. 10 lines 48-57, fig. 18 item 1802); and

(b) a RAM portion in which user-specific encrypted information is written (col. 10 lines 48-57) which makes the optical disk unique for a specific user (col. 10 lines 48-57) and in combination with the preformed identification signature provides a user-personalized secure signature that permits a user to communicate over a network to make payment for ordered products and services with a high degree of assurance that the information on the disk is secure from piracy (col. 12 lines 25-42).

Hurtado does not teach a hybrid optical disk having preformed identification information is stored in ROM. However Kajiyama et al. does teach this feature (fig. 10, lines 45-60. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the disk of Hurtado. Motive to make this combination is found in Kajiyama col. 1 lines 55-60 where the advantage of such an arrangement in disk anti-piracy schemes is noted.

As for claim 2, Hurtado teaches user personalized signature data that includes pre-payment information that permits prepayment in whole or in part (col. 10 lines 48-56).

As for claim 3, Hurtado teaches a disk that is shaped to be useable by a conventional optical disk drive (fig. 18 item 1802)

As for claims 4 and 5, Hurtado teaches a RAM portion (hence locally provided) that includes a series of interactive questions that solicit answers from the user to verify the authenticity of the user (col. 86 lines 25-35).

As for claim 7, it represents the method of use of the disk of claim 1 and is thereby rejected on the same basis as claim 1.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems of copy control and rights management in similar to that of the applicant.

Richardson, III	5,490,216
Lang	5,065,429
DeMont	5,982,889
Wyman	5,745,879

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

9/28/04

Paul Callahan